PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number: 15874-019001	
	Application Number 09/451,160	Filed November 30, 1999
	First Named Inventor Boal	
	Art Unit 3622	Examiner Arthur Duran

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
    is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record 52,713
                (Reg. No.)

☐ attorney or agent acting under 37 CFR 1.34.
    Registration number if acting under 37 CFR 1.34

_____
Signature

Alex Chan
Typed or printed name

(650) 839-5070
Telephone number

February 21, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.

☒ Total of 1 form is submitted.

50396828.doc

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Boal   Art Unit : 3622
Serial No. : 09/451,160   Examiner : Arthur Duran
Filed   : November 30, 1999   Conf. No. : 8692
Title   : ELECTRONIC COUPON DISTRIBUTION SYSTEM

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

<u>PRE-APPEAL BRIEF REQUEST FOR REVIEW</u>

This brief is filed in response to factual deficiencies in the Final Office Action mailed October 4, 2006. Claims 1-18 and 22-50 are pending in the action, with claims 24, 26, and 44 being independent.

Section 103(a) Rejections

Claims 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USP No. 6,360 to Linden in view of USP No. 6,321,208 to Barnett. Claim 24 recites in part associating a Uniform Resource Locator (URL) with the coupon, the **URL containing a promotional code**.

In the "Response to Arguments" section of the Office Action, the Examiner asserts that "Applicant's claims state minimal specific features as to the characteristics of the promotional code contained in the URL" and "the promotional code in the URL is open to a broad interpretation" (page 13, 4th ¶ of Office Action). Citing FIG. 3a, FIG. 9, and claim 29 of Linden, the Examiner further asserts that "the specific promotional code that identifies the specific promotion or specific coupon/promotion amount is included in the URL" of Linden (page 14, 1st ¶ of Office Action). Applicant respectfully disagrees.

Each private resource of Linden is assigned a private URL that includes a combination of a fixed <u>character string</u> and a <u>unique token</u> (1:56-58). The token includes fixed-length, numeric, alphanumeric or non-alphanumeric characters (3:58-61). As shown in FIGs. 9 and 10 and reproduced below, the private URL embedded in the hyperlink 74 and referencing the web page 78 containing information associated with a gift certificate has the form:

Address | http://amazon.com/gc/redeem/A9HBJ1E55GOML   ▼

where the character string "A9HBJ1E55G0ML" is the token (3:61-4:2). The token "A9HBJ1E55G0ML" identifies a **particular private resource**, such as by identifying a **particular user, user group, file or database account** (4:3-5). To generate the token, the user's <u>email address</u> is initially converted into a 36-bit email ID to be combined with a <u>time stamp</u> to establish a 64-bit integer value (8:25-31). The 64-bit value is then encrypted to generate a 64-bit token value ... to be used as the token in the private URL (8:42-48).

Claim 24 recites a "promotional code" contained in a URL, while Linden describes a "token value." The relied upon portions (i.e., FIG. 3a, FIG. 9, and claim 29) of Linden do not teach that the token value is a promotional code. A promotional code identifies a **promotion**, and Linden's token value is a code that identifies **a particular private resource**. **A private resource is not the same as a promotion. More specifically, a private resource identifies a web page that is associated with a particular user. Accordingly, the private resource is identified using**, for example, the **user's email address** and a **time stamp** representing a current date and time (i.e., in the form of a token). The token **does not identify a promotion**. The token identifies a webpage, which Applicant concedes can include any form of content. However, Applicant respectfully asserts that Linden's token that includes an email address and time stamp does not correspond to a promotional code. While the hyperlink 74 shown in FIG. 9 of Linden provides a URL to a gift certificate referenced in FIG. 10, the URL does not include a code that identifies a promotion (e.g., a buy-one-get-one-free voucher, $2.00 off coupon or free shipping offer, etc.).

Barnett does not cure the deficiencies of Linden. Barnett utilizes a coupon retrieval method that requires the printing of the actual coupon using a printer for redemption at a desired retail store (7:12-20 and FIG. 5). Barnett does not disclose using any URL (let alone to incorporate a promotional code in the URL) or invoking the URL with a browser to redeem a coupon. For at least these reasons, Applicant respectfully submits that claims 24-25 are allowable over Linden and Barnett, alone or in combination.

Section 103(a) Rejections

Claims 26-46 and 49-50 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over US Pub. No. 2003/0083931 to Lang in view of Barnett. Claim 26 recites in

part collecting device information from a client system, the device information being **insufficient to specifically identify a user** of the client system.

Lang describes a method of marketing that enables advertisers to more specifically target their advertising to users or their electronic devices according to web sites or files previously visited on a wide area network (WAN) ¶¶ 0011. Lang first identifies the electronic devices connected to the WAN (¶¶ 0014), obtains physical locations of these electronic devices (¶¶ 0015), and stores information regarding web sites or files visited over the WAN by users of the electronic devices (¶¶ 0016). All of these information are collected by a database generator to create user files for determining users to be targeted for a particular advertisement.

In the "Response to Arguments" section of the Office Action, the Examiner asserts that "the device [of Lang] is tracked and then information about a user is inferred based upon the activity of the device" (page 15, lines 3-4 of Office Action). The Examiner further asserts that while "the information of the electronic device is necessarily obtained and tracked[,] ... the user name or personal information is additional or optional information" (page 15, lines 2-3 of Office Action). Therefore, the Examiner concludes that "Lang discloses that just the device is tracked such that the user information can be inferred, however, the actual user is not necessarily known" (page 15, lines 5-6 of Office Action).

At (¶¶ 0017), Lang discloses that in **each** delivery scheme, the advertisements transmitted to the targeted users are based on: 1) **electronic device's ID** information; 2) the electronic device's or user's **network activities** on the WAN; and 3) the past, present or future **physical location** of the electronic device or user when connected to the WAN (¶¶ 0017). As will be discussed below, personal information sufficient to identify a user is required in order to retrieve each of these information.

First, Lang shows that an electronic device's ID information is assigned to a laptop 15 of a user upon the establishment of an account on the central server 50. Initially a client software program 22 supplied by the operator of the central server 50 must be loaded into the laptop 15. The user's **personal information** is then entered into the client software program 22 by the user 10 (¶¶ 0024). Such personal information includes "name, physical address and email address" (¶¶ 0031). In response, the central server 50 issues an electronic device's ID information to the laptop 15, and the laptop 15 connected to the WAN 8 is subsequently identified based on this

electronic device's ID information (¶¶ 0024). Accordingly, the user **is required** to submit personal information to the central server 50 in order to establish an account. The electronic device's ID information is assigned to the laptop 15 once a user's personal information, which identifies the user, is entered into client software program 22. Applicant respectfully asserts that there is no suggestion that the submission of such personal information is in any way optional, or that an account can be granted without the submission of personal information or identification of the user to the central server 50.

In a second operation mode, Lang describes that network activity information 53 regarding web sites or files visited by the user of the laptop 15 over the WAN 8 can be compiled. Such network activity information 53 may be obtained from the client software program 22 initially used to **log on** to the central server 50. Information regarding the web sites visited by the user 10 using the laptop 15 may also be obtained by reviewing "cookies" stored on the laptop 15 when connected to the central server 50 (¶¶ 0025). The log on process also requires the user to have an account established on the central server 50, and this account, as discussed above, **requires the submission of user's personal information**, such as **name**, **physical address** and **email address**, that identifies the user. There is no disclosure in Lang that supports that the network activity information 53 can be obtained without having an account or personal information of the user on the central server 50.

In a third mode of operation, Lang describes that each time the user uses the laptop 15 to connect to the central server 50, the past and present physical location information 54 of the laptop 15 connected to the WAN 8 is automatically downloaded to the central server 50 (¶¶ 0024). For example, when a user initially enters his automobile and starts his laptop computer, the laptop computer automatically connects to the Internet using the wireless internet service provider (ISP). Since the user has previously set up his account on the ISP, the central server immediately knows the user's ID information and begins to receive real time location information via the GPS receiver connected to the user's laptop computer (¶¶ 0024). Simply put, Lang tracks the exact physical location of the user using GPS satellites, "twenty-four hours per day, anywhere in the world" (¶ 0023). This tracking is performed upon verification of the user's account on the ISP. Applicant respectfully asserts that the ISP necessarily uses user's personal information (e.g., address where the service is to be provided, credit card or bank account

number to which the service will be billed, etc) that identifies the user to establish an account prior to providing, for example, internet services. It would be inappropriate to assert that such information is "insufficient to specifically identify a user of the client system." Further, Lang shows that real time location information is received and transmitted to the user's laptop once the user's ID information is known. As discussed above, this ID information is assigned to the laptop and known to the central server 50 once a user's personal information, such as name, physical address and email address, is entered into client software program 22. There is no disclosure in Lang that provides that the laptop can be tracked using such ID information without the submission of user's personal information.

Barnett fails to remedy the deficiencies of Lang, as Barnett teaches that users' social security numbers (which specifically identify the users) should be bar-coded onto every coupon the users print. Thus, for at least the foregoing reasons, Lang and Barnett fail to teach "collecting device information insufficient to specifically identify a user".
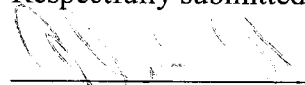
For at least these reasons, Applicant respectfully submits that claim 26 is allowable over Linden, Barnett and Lang, alone or in combination. Claims 27-43 and 49 depend from claim 26, and also are submitted to be allowable for the same reasons discussed with respect to claim 26.

Claim 44 recites in part means for collecting device information being **insufficient to specifically identify a user**. As discussed *supra*, neither Lang nor Barnett disclose or suggest collecting device information being insufficient to specifically identify a user, nor the means for doing so. For at least these reasons, Applicant respectfully submits that claim 44 is allowable over Linden and Barnett, alone or in combination. Claims 45-46 and 50 depend from claim 44, and also are submitted to be allowable for the same reasons discussed with respect to claim 44.

The fees for the extension of time and notice of appeal are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization.

Respectfully submitted,

Date:____2/21/07_____

Alex H. Chan (Reg. No. 52,713)

Customer No. 26181
Fish & Richardson P.C.
Telephone: (650) 839-5070
Facsimile: (650) 839-5071